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09/130,998	08/07/1998	MICHAEL STERN	15818-005000	7187

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EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT	PAPER NUMBER
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2163

DATE MAILED: 12/21/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/130,998

Applicant(s)

STERN, MICHAEL

Examiner

Susanna M. Diaz

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10-14, 21-24, 26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-14, 21-24, 26 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTC-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Continued Prosecution Application***

1. The request filed on September 5, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) is acceptable and a CPA has been established. An action on the CPA follows.

Claims 1-7, 10-14, 21-24, 26, and 27 are pending.

### ***Specification***

2. The disclosure is objected to because of the following informalities: Page 15, line 5 through Page 18, line 42 of the specification should be 1½ or double-spaced.

Appropriate correction is required.

### ***Claim Objections***

3. Claim 10 is objected to because of the following informalities:

Claim 10, line 4, delete "create", insert --creating--

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-7, 10, 11, 14, 21-23, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

[Claim 1] There is no antecedent basis for "said database" (line 6). For examination purposes, "said database" will be interpreted as "said network management center."

Claims 2-7, 21, and 23 are dependent from claim 1 and thereby inherit the same rejection.

[Claims 2, 6] It is not clear what it meant by "wherein the perceivable stimulus...create statistical data" (lines 3-4). The perceivable stimulus does not create any data per se, much less statistical data. It seems more likely that a central processor would create statistical data and the end client would gather statistical data. For examination purposes, the limitation in question will be interpreted as such.

Claim 6 is dependent from claim 2 and thereby inherits the same rejection.

[Claim 14] There is no antecedent basis for "said end client" (line 5). For examination purposes, "said end client" will be interpreted as "said one of said end clients."

Claims 22 and 24 are dependent from claim 14 and thereby inherit the same rejection.

[Claim 11] It is not clear how the providing step per se defines statistical data (lines 2-3). Instead, it seems more likely that a central processor would carry out a step for creating statistical data and the end client would conduct a step of gathering statistical data. For examination purposes, the limitation in question will be interpreted as such.

[Claims 21, 22] The limitation “to maximize association of said stimulus with said product” (found in line 2 of both claims 21 and 22) is vague and indefinite. It is not clear how a maximized association of a stimulus is identified (i.e., measured or assessed). For examination purposes, this limitation will be interpreted as “to encourage the consumer to purchase said product” (e.g., provide a noticeable advertisement for the product).

[Claim 21] There is no antecedent basis for “said site” (line 1). For examination purposes, “said site” will be interpreted as “one of said end clients.”

[Claim 22] There is no antecedent basis for “said site” (line 1). For examination purposes, “said site” will be interpreted as “said one of said end clients.”

[Claim 27] The preamble of claim 27 states, “The computer program product as recited in claim 10”; however, claim 10 is a method claim. Therefore, there is no antecedent basis for “the computer program product.” Furthermore, claim 27 is a duplicate of claim 26, but with a preamble referring to a computer program product instead of a method (as recited in claim 26). The limitation recited in the body of claim 27 is addressed in the art rejection below.

Appropriate correction is required.

### ***Response to Arguments***

6. Applicant’s arguments with respect to claims 1-7, 10-14, 21-24, 26, and 27 have been considered but are moot in view of the new grounds of rejection, which were necessitated by Applicant’s amendment to the claims.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

8. Claims 1-6, 10-13, 21, 23, 26, and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Kaplan (U.S. Patent No. 5,963,916).

Kaplan (U.S. Patent No. 5,963,916) discloses a method of disseminating information concerning a product, both of which are to be perceived by a consumer, said method comprising:

[Claim 1] providing a network management center that receives files from content providers (Fig. 2; col. 9, lines 16-35 -- Since the store is vending music from content providers, its network management center must somehow receive the music files from the respective content providers);

transmitting said designated files with advertising information and inventory information to end clients remotely disposed with respect to said database, wherein each end client receives only its designated files (Figs. 40, 46; col. 9, lines 16-35; col. 11, lines 37-39 -- The availability of a product corresponds to inventory information. Furthermore, the mere fact that the kiosk allows users to preview music implies some

sort of availability, i.e., inventory, information; col. 12, lines 48-51 -- The selected music is retrieved from the memory at the central location, i.e., the network management center);

providing a perceivable stimulus, from said designated files to said consumer, said perceivable stimulus being associated with said product (Figs. 35-57); and

wherein an interactive consumer stimulus initiated by the consumer includes said perceivable stimulus (Figs. 35-57; col. 11, lines 11-20 -- The user interacts with the kiosk to respond to the displays. For example, he/she may preview a product, order a product, respond to survey questions, etc.);

[Claim 2] wherein the perceivable stimulus is repeated multiple times and creates statistical data (Figs. 35-57 -- The perceivable stimulus may be produced repeatedly; col. 7, line 14 through col. 8, line 17; col. 10, line 66 through col. 11, line 10 -- The perceivable stimulus may be reproduced repeatedly for multiple users);

[Claim 3] wherein transmitting includes forming, from a subportion of said designated files, a distribution database having content data, with said content data being defined by said perceivable stimulus (Figs. 35-42; col. 12, lines 57-62 -- The user is shown advertisements for different albums and may choose one of them for purchase);

[Claim 4] wherein said perceivable stimulus is dependent upon criteria of an ambient proximate to said product (Figs. 35-42; col. 6, lines 63-64 -- The user is physically in a music store and the kiosk in the store advertises and enables purchase of music);

[Claim 5] wherein said perceivable stimulus is selected from the set consisting of auditory, visual, olfactory and tactile (Figs. 35-42);

[Claim 6] conveying said statistical data to said database (col. 7, line 14 through col. 8, line 17);

[Claim 21] wherein said site is disposed a distance from said product to maximize association of said stimulus with said product (col. 6, lines 63-65);

[Claim 23] wherein said interactive consumer stimulus is initiated by a consumer scanning a UPC code on said product (col. 14, line 62 through col. 15, line 3).

Kaplan (U.S. Patent No. 5,963,916) discloses a method of disseminating information concerning multiple products, said method comprising:

[Claim 10] receiving files from content providers (Fig. 2; col. 9, lines 16-35 -- Since the store is vending music from content providers, the store must somehow receive the music files from the respective content providers);

assigning at least one attribute for each file and creating designated files for distribution to end clients (col. 12, lines 57-62);

creating a database containing said designated files (col. 9, lines 16-35; col. 12, lines 48-62);

selecting a plurality of end clients (Figs. 40, 46; col. 9, lines 16-35; col. 12, lines 48-62);

transmitting said designated files with advertising information and inventory information to end clients with each end client receiving only its designated files,



wherein said end clients are remotely disposed with respect to said database, with subsets of said end clients corresponding to differing products, including transmitting information corresponding to a first of said multiple products to one of said end clients (Figs. 40, 46; col. 9, lines 16-35; col. 11, lines 37-39 -- The availability of a product corresponds to inventory information. Furthermore, the mere fact that the kiosk allows users to preview music implies some sort of availability, i.e., inventory, information; col. 12, lines 48-51 -- The selected music is retrieved from the memory at the central location, i.e., the network management center);

providing a perceivable stimulus, from said information corresponding to said first of said products, to a consumer positioned proximate to said one of said end clients, with said perceivable stimulus being associated with said first of said multiple products (Figs. 35-57); and

wherein an interactive consumer stimulus initiated by said consumer includes said perceivable stimulus (Figs. 35-57; col. 11, lines 11-20 -- The user interacts with the kiosk to respond to the displays. For example, he/she may preview a product, order a product, respond to survey questions, etc.);

[Claim 11] wherein said providing step is repeated multiple times and defines statistical data (Figs. 35-57 -- The perceivable stimulus may be produced repeatedly; col. 7, line 14 through col. 8, line 17; col. 10, line 66 through col. 11, line 10 -- The perceivable stimulus may be reproduced repeatedly for multiple users);

[Claim 12] wherein creating further includes accumulating content associated with a subgroup of said multiple products and associating said content with parameters, said

parameters including group definitions and date ranges (Figs. 38, 40 -- Users may view music titles by genre, i.e., group definition, or they may choose the category of "new releases" which implies a date range);

[Claim 13] wherein transmitting includes forming a distribution database having a plurality of records, said plurality of records including a subportion of said content and corresponding to a server address, with a subpart of said plurality of end clients being associated with said server address (col. 12, lines 48-62);

[Claim 26] wherein said perceivable stimulus is dependent upon criteria of an ambient proximate to said product (Figs. 35-42; col. 6, lines 63-64 -- The user is physically in a music store and the kiosk in the store advertises and enables purchase of music);

[Claim 27] wherein said perceivable stimulus is dependent upon criteria of an ambient proximate to said product (Figs. 35-42; col. 6, lines 63-64 -- The user is physically in a music store and the kiosk in the store advertises and enables purchase of music).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claims 7, 14, 22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan (U.S. Patent No. 5,963,916), as applied to claims 3 (for claim 7) and 13 (for claims 14, 22, and 24) above.

[Claims 7, 14] Kaplan teaches a music preview embodiment in which an in-store kiosk accesses music information from a remote web site. His web site server is "able to service a plurality of kiosks across the country or across the world" (col. 9, lines 29-30). Kaplan also discloses the "decompression of audio information to the subscriber" (col. 6, lines 11-12), which implies an initial compression of said audio information; however, Kaplan fails to explicitly disclose the distribution of his compressed distribution files to his respective kiosk sites via satellite. The Examiner asserts that satellite communications are old and well-known in the art. As a matter of fact, satellite communications are commonly used to transmit Internet information "across the world." Therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to enable Kaplan's invention to utilize satellite communications to distribute compressed distribution files to the respective end user sites in order to facilitate quick and efficient global communications.

[Claim 22] Kaplan discloses that said site is disposed a distance from said product to maximize association of said stimulus with said product (col. 6, lines 63-65).

[Claim 24] Kaplan discloses that said interactive consumer stimulus is initiated by a consumer scanning a UPC code on said product (col. 14, line 62 through col. 15, line 3).

**Conclusion**

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Herz et al. (U.S. Patent No. 5,758,257) -- Discloses a kiosk where potential buyers may preview music and/or book excerpts in a music and/or book store.

Tsevdos et al. (EP 0649121 A2) -- Discloses an Internet point-of-sale terminal operated through a kiosk. Customers may preview desired digital content and order it online.

"Handleman Company Announces Plans to Bring Internet Music Purchasing to Its Mass Merchant Customers Through Alliance with Intouch Group, Inc." -- Discloses Intouch Group Inc.'s "i-stations" which allow users to preview and purchase music at an in-store kiosk with Internet access. This product seems to correspond to the invention taught in U.S. Patent No. 5,963,916, especially since the assignee (Intouch Group, Inc.) and inventor (Joshua Kaplan) are both mentioned in the article.


"Topic of Discussion at Multimedia Expo East '94" -- Discloses Intouch Group Inc.'s "i-stations" which allow users to preview and purchase music at an in-store kiosk with Internet access. This product seems to correspond to the invention taught in U.S. Patent No. 5,963,916, especially since the assignee (Intouch Group, Inc.) and inventor (Joshua Kaplan) are both mentioned in the article.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Thursday, 5:30 am - 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for Official communications, (703) 746-7240 for Non-Official communications, and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900 or to the Customer Service Office on (703) 306-5631.

SMD  
December 17, 2001

  
Kyle Choi  
Patent Examiner  
Art Unit 2163